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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/552,668	10/05/2005	Yoichi Ikematsu	52433/821	7228
26646 7590 05/20/2009 KENYON & KENYON LLP ONE BROADWAY NEW YORK, NY 10004				
EXAMINER				
ZIMMERMAN, JOHN J				
ART UNIT		PAPER NUMBER		
1794				
MAIL DATE		DELIVERY MODE		
05/20/2009		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/552,668

Applicant(s)

IKEMATSU ET AL.

Examiner

John J. Zimmerman

Art Unit

1794

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 February 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SF/ICE)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

SECOND OFFICE ACTION

Amendments

1. This Second Office Action is in response to the correspondence titled "AMENDMENT" received February 6, 2009. Claim 1 is pending in this application.

Claim Rejections - 35 USC § 102/103

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claim 1 is rejected under 35 U.S.C. 103(a) as being unpatentable over Honda (JP 2001-323355).

5. Honda discloses a high strength galvanized steel sheet having excellent corrosion resistance and platability wherein example compositions of the steel include 0.072 wt.% C, 0.4 wt.% Si, 0.82 wt.% Mn, 0.01 wt.% P, 0.006 wt.% S, 0.071 wt.% Al, 0.062 wt.% Ti (e.g. example B in Table 1) or 0.084 wt.% C, 0.1.83 wt.% Si, 2.35 wt.% Mn, 0.004 wt.% P, 0.005 wt.% S, 0.063 wt.% Al, 0.018 wt.% Ti, 0.017 wt.% Nb (e.g. example E in Table 1). The zinc plating composition can include 0.2-10 wt.% aluminum (e.g. see paragraph [0023]). These steel compositions fall within the steel composition ranges required by applicant's claim 1. Although Honda may not require that the steel sheet structure include at least 2% to 20% by vol% of an austenite phase in a ferrite phase, no steps other than having a composition within the claimed ranges are disclosed by applicant to be necessary to obtain this structure and therefore, barring evidence to the contrary, Honda's steel sheet which meets the claimed composition requirements would be considered to meet the phase limitation. Honda's steel plates are subject to annealing where moisture pressure and hydrogen content pressure ($\text{PH}_2\text{O}/\text{PH}_2$) are operated by introducing steam into the furnace (e.g. [0036]-[0037], [0046]). Honda reveals that by controlling the atmosphere during treatment, SiO_2 is changed to an internal oxidation state within 3 microns or less from the steel surface (e.g. see paragraphs [0007]-[0009], [0038]). Although Honda may not require the Si oxide to have an average diameter particle size of 0.001-1 μm , in view of similarities in Honda's process to applicant's process, one of ordinary skill in the art would expect the end products to have the same or substantially the same microstructures. Patent and Trademark Office can require applicants to prove that prior art products do not necessarily or inherently possess characteristics of claimed products where claimed and prior art products are identical or substantially identical, or are produced by identical or substantially identical

processes; burden of proof is on applicants where rejection based on inherency under 35 U.S.C. § 102 or on prima facie obviousness under 35 U.S.C. § 103, jointly or alternatively, and Patent and Trademark Office's inability to manufacture products or to obtain and compare prior art products evidences fairness of this rejection, *In re Best, Bolton, and Shaw*, 195 USPQ 431 (CCPA 1977). It should also be noted that when there is a substantially similar product, as in the applied prior art, the burden of proof is shifted to the applicant to establish that their product is patentably distinct not the examiner to show that the same process of making, see *In re Brown*, 173 U.S.P.Q 685, and *In re Fessmann*, 180 U.S.P.Q. 324. Although Honda may differ from the claim in that Honda may not require the same annealing temperature range, one of ordinary skill in the art at the time the invention was made clearly understands the effect of the annealing temperature on the treatment of the steel substrate and would also clearly understand that the temperature range would need to be optimized for platability during galvanizing as intended by Honda. Determining the annealing temperature range that would best deliver Honda's goal of a SiO₂ internal oxidation state within 3 microns or less from the steel surface would be a mere matter of routine experimentation by one of ordinary skill in the art. In addition, although Honda may differ from the claim in that Honda may not recite the PH₂O/PH₂ ratio range in the same manner, Honda clearly shows recognition that the PH₂O/PH₂ ratio is a result effective variable for plating adhesion in high strength galvanized steel sheet and therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to optimize the ratio for this specific purpose. As it is clear that the result of Honda's PH₂O/PH₂ ratio is the formation of SiO₂ as internal oxidation within 3 microns or less from the steel surface (e.g. see paragraphs [0007]-[0009], [0038]), it would be expected that Honda's ratio falls within, overlaps and/or is

patentably indistinct from the parameters of applicant's claimed range. Although Honda may not express his optimization in the same formula type format as is found in applicant's claim, merely describing Honda's optimization in a different type of format is not a patentable distinction over the invention of Honda.

6. Claim 1 is rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Kyono (U.S. Patent 6,398,884).

7. Kyono discloses galvanized steel sheet having wherein the example compositions fall within the claimed ranges for C, Si, Mn, etc. . . (e.g. examples G-J in Table 1). Although Kyono may not require that the steel sheet structure include at least 2% to 20% by vol% of an austenite phase in a ferrite phase, no steps other than having a composition within the claimed ranges are disclosed by applicant to be necessary to obtain this structure and therefore, barring evidence to the contrary, Kyono's steel sheet which meets the claimed composition requirements would be considered to meet the phase limitation. The zinc plating composition can include 0.14 wt.% aluminum (e.g. see Example 1 in column 17). Kyono's steel plates are subject to annealing where internal oxide layer occurs in the surface of the steel sheet (e.g. see column 3, lines 24-30). The internal oxides include silicon and manganese oxides (e.g. column 6, lines 17-24). Although Kyono may not describe that the oxides have an average diameter particle size of 0.001-1 μm as in pending claim 1, in view of the similar use of an internal oxidation process, barring evidence to the contrary one of ordinary skill in the art would expect the end products to have substantially similar microstructures at substantially similar depths from the interface.

Patent and Trademark Office can require applicants to prove that prior art products do not necessarily or inherently possess characteristics of claimed products where claimed and prior art products are identical or substantially identical, or are produced by identical or substantially identical processes; burden of proof is on applicants where rejection based on inherency under 35 U.S.C. § 102 or on prima facie obviousness under 35 U.S.C. § 103, jointly or alternatively, and Patent and Trademark Office's inability to manufacture products or to obtain and compare prior art products evidences fairness of this rejection, *In re Best, Bolton, and Shaw*, 195 USPQ 431 (CCPA 1977). It should also be noted that when there is a substantially similar product, as in the applied prior art, the burden of proof is shifted to the applicant to establish that their product is patentably distinct not the examiner to show that the same process of making, see *In re Brown*, 173 U.S.P.Q 685, and *In re Fessmann*, 180 U.S.P.Q. 324.

8. Claim 1 is rejected under 35 U.S.C. 103(a) as being unpatentable over Suzuki (JP 2000-290730).
9. Suzuki discloses a high strength galvanized steel sheet having an excellent balance of strength and ductility wherein example compositions of the steel fall within the claimed ranges for C, Si, Mn etc. . . (e.g. examples 1-13 in Table 1). Although Suzuki may not require that the steel sheet structure include at least 2% to 20% by vol% of an austenite phase in a ferrite phase, no steps other than having a composition within the claimed ranges are disclosed by applicant to be necessary to obtain this structure and therefore, barring evidence to the contrary, Suzuki's steel sheet which meets the claimed composition requirements would be considered to meet the

phase limitation. The zinc plating composition can include 0.08-0.2 wt.% aluminum (e.g. see paragraph [0049]). Suzuki's steel plates are subject to annealing where the atmosphere is optimized by varying the H_2O/H_2 ratio in a temperature range of 800-1000 °C and results in internal oxidation of a silicon content in the steel (e.g. [0006]-[0019], [0037]-[0040], Table 1). Suzuki reveals that by controlling the atmosphere during treatment, an internal oxidation involving Fe, Si and Mn within several microns from the steel surface occurs (e.g. see paragraph [0017]). Although Suzuki may not require the Si oxide to have an average diameter particle size of 0.001-1 μm , in view of similarities in Suzuki's process to applicant's process, one of ordinary skill in the art would expect the end products to have the same or substantially the same microstructures. Patent and Trademark Office can require applicants to prove that prior art products do not necessarily or inherently possess characteristics of claimed products where claimed and prior art products are identical or substantially identical, or are produced by identical or substantially identical processes; burden of proof is on applicants where rejection based on inherency under 35 U.S.C. § 102 or on prima facie obviousness under 35 U.S.C. § 103, jointly or alternatively, and Patent and Trademark Office's inability to manufacture products or to obtain and compare prior art products evidences fairness of this rejection, *In re Best, Bolton, and Shaw*, 195 USPQ 431 (CCPA 1977). It should also be noted that when there is a substantially similar product, as in the applied prior art, the burden of proof is shifted to the applicant to establish that their product is patentably distinct not the examiner to show that the same process of making, see *In re Brown*, 173 U.S.P.Q 685, and *In re Fessmann*, 180 U.S.P.Q. 324. Although Suzuki may differ from the claim in that Suzuki may not require the same annealing temperature range endpoints, the temperature ranges overlap and therefore the process

would be expected to be patentably indistinct in the overlapped portions. In addition, although Suzuki may differ from the claim in that Suzuki may not recite the H_2O/H_2 ratio range in the same manner, Suzuki clearly shows recognition that the H_2O/H_2 ratio is a result effective variable for plating adhesion in high strength galvanized steel sheet and therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to optimize the ratio for this specific purpose. As it is clear that the result of Suzuki's H_2O/H_2 ratio is the formation of silicon oxides as internal oxidation within several microns from the steel surface (e.g. see paragraph [0017]), it would be expected that Suzuki's ratio falls within, overlaps and/or is patentably indistinct from the parameters of applicant's claimed range. Although Suzuki may not express his optimization in the same formula type format as is found in applicant's claim, merely describing Suzuki's optimization in a different type of format is not a patentable distinction over the invention of Suzuki.

Response to Arguments

10. Applicant's arguments filed February 6, 2009 have been fully considered but they are not persuasive for the following reasons: The applicant has submitted various comparative results in order to show that the zinc plated sheets made by the processes of the applied prior art differ from the zinc plated sheets made by the process required by the pending claim. The comparative results, however, were not submitted in the form of an affidavit/declaration. Therefore, the data and the related conclusions submitted by applicant could be given little weight. It is suggested that applicant submit the results in the form of an affidavit/declaration under 37 C.F.R. 1.132 so that the results and their related conclusions can be considered in determining whether the

claimed subject matter patentably distinguishes over the subject matter of the applied Honda, Kyono and Suzuki references.

Conclusion

11. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a). A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to John J. Zimmerman whose telephone number is (571) 272-1547. The examiner can normally be reached on 8:30am-5:00pm, M-F. Supervisor Jennifer McNeil can be reached on (571) 272-1540. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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13. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

John J. Zimmerman
Primary Examiner
Art Unit 1794

/John J. Zimmerman/
Primary Examiner, Art Unit 1794

jjz
May 15, 2009